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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,593	05/30/2001	John J. Ryan III	274	4947

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EXAMINER

MORRISON, NASCHICA SANDERS

ART UNIT PAPER NUMBER

3632

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SL

Office Action Summary

Application No.

09/866,593

Applicant(s)

RYAN ET AL.

Examiner

Naschica S Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 11-16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 11-16 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

This is the second Office Action for serial number 09/866,593, Insulating Wire Separator Apparatus for Piping Systems, filed on May 30, 2001. Claims 2-9, 11-16, 18-23 are pending.

Specification

Note: The page and line numbers referenced below correspond to the pages and lines of the amendment filed 8/9/02.

The disclosure is objected to because of the following informalities: on page 15, line 2, page 16, lines 18 and 21, and page 19, line 20 delete "caused"; on page 21, line 6, "about inches to six inches" is confusing, on line 15 insert --of-- before "the opening"; on page 22, line 2 insert --of-- before "a tracer wire"; on page 23, line 9 "resisting" should be --preventing--. Appropriate correction is required.

Claim Objections

Claims 3 and 11 are objected to because of the following informalities: on line 4 and 2 respectively, delete ", " after "post". Appropriate correction is required.

Claim 9 is objected to because of the following informalities: on line 2 insert --a-- after "having". Appropriate correction is required.

Claim 10 is objected to because of the following informalities: on line 12 insert "at right angles" should be -- at a right angle--. Appropriate correction is required.

Claim 16 is objected to because of the following informalities: on line 2 insert --a-- after "having". Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) *not mentioned in the description*: "Q" in Figure 7A. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they *do not include* the following reference sign(s) mentioned in the description: 2-2 on page 4, line 22; 3-3 on page 5, line 3; 122 on page 7, line 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 6, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,601,260 to Shinohara et al. (Shinohara). With regards to claims 2, 6, and 21, Shinohara discloses a wire support (Fig. 2) made of resin comprising: a resilient main conduit receiving portion (41 adjacent 14) having an inner radius and an opening (between 50 and 54A); an I-beam arm portion (extending between 20 and 14) extending a distance beyond the main conduit receiving portion (41 adjacent 14) on the side opposite the opening (between 50 and 54A); a plate portion (46 located between 41 and 52) extending at right angles from the arm portion in proximity to the conduit receiving portion (41 adjacent 14); a wire clip portion (41 adjacent 12) having a pair of fingers (50,52) and positioned at the end opposite the main conduit receiving portion; and a separator post (30,40) extending at right angles from the arm portion and spaced from the plate portion, the arm portion extending beyond the separator post (30,40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,601,260 to Shinohara et al. (Shinohara). Regarding claim 3, arguably Shinohara teaches the arm portion extending at least two inches beyond the separator post (30). Additionally, Shinohara does not explicitly teach the separator post

spaced at least ten inches from the plate portion. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the arm portion and separator post to extend the specified distances since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 5, Shinohara does not disclose the wire support being color-coded. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire support to be of various colors because one would have been motivated to provide a device that is aesthetically pleasing.

Regarding claims 7 and 8, Shinohara discloses the wire support as applied to claim 21 above, but does not teach the opening (between 50 and 54A) being angled from sixty to eighty degrees or the wire clip finger portion (41 adjacent 12) being angled from three to thirty degrees from the centerline of the arm portion (20). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the opening of the main conduit receiving portion to be angled between sixty and eighty degrees or the wire clip finger portion to be angled between three and thirty degrees since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of U.S. Patent 5,772,166 to Adams. With regards to claim 9,

Shinohara discloses the wire support as applied to claim 21 above, but does not teach the main conduit receiving portion comprising first and second half radiused portions. Adams discloses a mounting clip comprising a main conduit receiving portion (Fig. 11) including a first half radiused portion (132) releasably fastened to a second half radiused portion (134) by a releasable fastening means (140,142). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to include first and second half radiused portions releasably fastened together because one would have been motivated to provide a means for adjusting the position of the item secured therein as taught by Adams (col. 8, lines 13-20).

Claims 4, 11-15, 19, 20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view of U.S. Patent 5,018,260 to Ziu. With regards to claims 4, 11-15, 19, 20, 22 and 23, Shinohara discloses the wire support as applied to claim 21 above, but does not disclose the main conduit receiving portion including a strengthening rib. Adams discloses a wire clip comprising a main conduit receiving portion (18) including an outer rib (40) extending thereabout. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire support of Shinohara by including an outer rib because one would have been motivated to provide a stronger gripping support as taught by Ziu (col. 5, lines 56-58).

Regarding claims 22 and 23, Shinohara in view of Ziu does not explicitly teach the wire clip portion (41 adjacent 12) located midway between the separator post (30)

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and centerline of the main conduit receiving portion or the separator post spaced at least ten inches from the plate portion. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire clip portion (41 adjacent 12) to be located midway between the separator post and the centerline of the main conduit receiving portion, and modified the separator post to be spaced ten inches from the plate portion since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claims 11, 22, and 23, arguably Shinohara in view of Ziu teaches the arm portion extending at least two inches beyond the separator post (30). However, Shinohara in view of Ziu does not explicitly teach the separator post extending two inches from the arm portion or the arm portion extending at least two inches beyond the separator post. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the separator post to extend two inches from the arm portion or the arm portion to extend at least two inches beyond the separator post since it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claims 12 and 20, Shinohara in view of Ziu does not disclose the wire support being color-coded. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wire

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support to be of various colors because one would have been motivated to provide a device that is aesthetically pleasing.

Regarding claims 14 and 23, Shinohara in view of Ziu does not disclose the opening (between 50 and 54A) being angled from sixty to eighty degrees. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the opening to be sized within the specified range since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Regarding claims 15 and 19, Shinohara in view of Ziu does not teach the wire clip finger portion (41) being angled from three to thirty degrees from the centerline of the arm portion (20). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to be angled between sixty and eighty degrees or the wire clip finger portion to be angled between three and thirty degrees since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara in view Ziu as applied above, and further in view of U.S. Patent 5,772,166 to Adams. With regards to claims 16 and 18, Shinohara in view of Ziu discloses the wire support as applied to claims 10 and 17 above, but does not teach the main conduit receiving portion comprising first and second half radiused portions. Adams discloses a mounting clip comprising a main conduit receiving portion (Fig. 11)

including a first half radiused portion (132) releasably fastened to a second half radiused portion (134) by a releasable fastening means (140,142). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the main conduit receiving portion to include first and second half radiused portions releasably fastened together because one would have been motivated to provide a means for adjusting the position of the item secured therein as taught by Adams (col. 8, lines 13-20).

Response to Arguments

Applicant's arguments filed 8/9/02 have been fully considered but they are not persuasive.

In response to applicant's argument that the invention of Shinohara discloses securing the retainer in a mounting hole through a mounting plate, thus teaching away from applicant's invention and further that it would not work to separate a tracer wire from a main conduit, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is *capable of performing the intended use*, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).


Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine telephone number for the Technology Center is (703) 305-3598 (formal amendments) or (703) 308-3519 (informal communications).

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 308-2168.


Naschica S. Morrison
Patent Examiner - Art Unit 3632
12/12/02


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PRIMARY EXAMINER